

REMARKS

In the Notice, the Office stated that Applicants' Amendment dated December 15, 2005 ("Previous Amendment") was non-responsive because it allegedly claimed inventions independent of or distinct from those constructively elected by the Applicants' previous presentation. Specifically, the Office stated the Previous Amendment was not fully responsive because the "amended claims are directed to an invention that is independent or distinct from the original [claims] since 'method for dispersing the color or providing intense color' is different from 'increasing the intensity of the color' as presented." Applicants respectfully disagree with the Office's position, at least because the Office improperly ignored the common effect recited in pending claims 96 and 203, because the Office did not show a serious burden in examining the amended claims, and because the Office improperly refused to consider claims 96 and 203.

Amendment to the Claims

Applicants have amended claim 1 herein to delete the word "cosmetic" from the phrase "increase the intensity of color in said cosmetic composition." Applicants submit that this amendment merely reconciles that language to the remaining recitations of that claim and does not result in the addition of any new matter. Therefore, Applicants request that the amendment be entered without objection.

Claims 1 and 195 Do Not Meet the Standard for a Restriction Requirement

In the Reply to Office Action dated March 22, 2005 ("March Reply"), claim 96 recited, *inter alia*, "a method of providing at least one property chosen from gloss and

intense color to a composition . . . wherein said at least one heteropolymer is included in said composition in an amount effective to disperse said at least one coloring agent.”¹

See page 7. Claim 203 also contained recitations directed to a “cosmetic composition.”²

See pages 13-14. Thus, claims 96 and 203 both recited, *inter alia*, a method of providing intense color. The Office examined those claims and provided a non-final Office Action dated June 15, 2005, which contained certain rejections of those claims and their dependencies over the cited references.

At least one effect of the methods recited in those claims is intense color in a composition or cosmetic composition, whether intense color is provided or the intensity of color is increased. As such, claims 96 and 203 share a common effect with amended claims 1 and 195, which presently recite, *inter alia*, methods of increasing the intensity of color. That common effect shows that the subject matter of claims 96 and 203, which has already been examined, is not independent from the subject matter of amended claims 1 and 195. “Inventions as claimed are independent if there is no disclosed relationship between the inventions, that is, they are unconnected in design, operation, and effect.” MPEP § 806.06 (emphasis added).

¹ In the Previous Amendment, Applicants amended claim 96 to recite, *inter alia*, “a method of providing intense color to a composition . . . wherein said at least one heteropolymer is included in said composition in an amount effective to provide said intense color.” See page 7.

² In the Previous Amendment, Applicants amended claim 203 to recite, *inter alia*, “a method of providing intense color to a cosmetic composition . . . wherein said at least one heteropolymer is included in said cosmetic composition in an amount effective to provide said intense color.” See pages 13-14.

Because the amended claims share a common effect with claims already examined in this application, and therefore do not recite independent inventions, claims 1 and 195 cannot now be refused entry and examination. The proper standard for restriction based on a previous presentation of claims is stated in 37 C.F.R. § 1.145:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

(Emphasis added.) Therefore, in order for the Office to properly refuse to enter the amended claims, or to properly impose a restriction requirement as to the amended claims, the amended claims must recite an invention both distinct from and independent of an invention previously claimed. *See* MPEP § 821.03. Yet in the Notice, the Office states that the "amended claims are directed to an invention that is independent or distinct from the original [claims]" (emphasis added). That is not the correct standard, as both independence and distinctness are required for restriction after an office action.

As shown above, amended claims 1 and 195 share a common effect with claims 96 and 203, which have already been examined this application. That common effect reveals that, under the proper standards presented in the Rules and the MPEP, those claims do not recite independent inventions. As independence is required for a proper restriction of amended claims after an office action, claims 1 and 195 are properly presented and cannot now be subject to the restriction requirement in the Notice.

The Examiner Showed No Serious Burden to Examine Amended Claims 1 and 195

In any proper restriction requirement, the Office must establish a serious burden in examining all of the claims in one application. *See MPEP § 803(l).* To show a serious burden, the Office must show one of: (1) separate classification of the inventions, (2) a separate status in the art of the inventions when they are classifiable together, and (3) a different field of search. *See MPEP § 808.02.* The Notice does not provide any explanation or recognition that the amended claims of the Previous Amendment would result in a serious burden on the Office to examine them in this application. Applicants submit that the Office cannot make such a showing at least because the amended claims recite at least some common subject matter—regarding the intensity of color—with claims previously examined by the Office, as shown above. Therefore, for at least this additional reason, the Notice is improper and the amended claims should be examined.

The Notice Improperly Ignores Independent Claims 96 and 203

The Office made no mention of independent claims 96 and 203 in the Notice. In the Previous Amendment, Applicants amended claims 96 and 203, in part, by deleting “at least one property chosen from gloss.” In fact, amended claim 203 differs from previous claim 203 only by deleting “at least one property chosen from gloss” in both instances where that phrase is recited in the claim. Yet in the Notice, the Office effectively refused to continue its examination of claims 96 and 203 and their dependencies. The lone ground for the Office’s position articulated in the Notice, that the original claims did not recite “increasing the intensity of the color,” is irrelevant to

amended claims 96 and 203. Claims 96 and 203 recite methods for, *inter alia*, "providing intense color." There should be no issue with regard to claims 96 and 203 relating to term "increasing" in claims 1 and 195, as claims 96 and 203 do not include such a recitation. Therefore, the Office should examine those claims and their dependencies as they are properly presented for consideration in this application.

Conclusion

In view of the foregoing, Applicants respectfully submit that the Notice is improper because, due to the shared common effect of claims 1 and 195 with previously examined claims 96 and 203, the standard of 37 C.F.R. § 1.145 is not met. Moreover, the Notice does not establish a serious burden on the Office to examine amended claims 1 and 195, and it improperly ignores claims 96 and 203 and their dependencies. Therefore, Applicants request the withdrawal of the Notice, the entry of the Previous Amendment, the continued examination of this application, and the timely allowance of pending all claims. The claims presented in the Previous Amendment are neither anticipated by nor rendered obvious by the references of record in this application for at least the reasons indicated in pages 17-25 of that paper.

Should the Office have any questions regarding this Response, or wish to discuss this application, Applicants invite the Office contact the undersigned.

RESPONSE TO NOTICE OF NON-RESPONSIVE AMENDMENT

Application No. 10/699,780

Application No. 05725.0895-02000

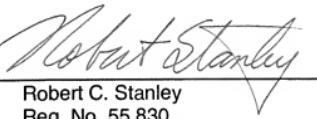
Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: July 3, 2006

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